

REMARKS/ARGUMENTS

Claims 1 and 33-59 were pending in the present application. Claims 2-32 were earlier withdrawn from consideration. By virtue of this response, no claims have been cancelled, no claims have been amended, and no new claims have been added. Accordingly, Claims 1 and 33-59 are currently under consideration.

In the current Office Action in this case having a mailing date of February 6, 2004, the Examiner reopened prosecution with a non-final new rejection. First, the Examiner is thanked for his consideration of the Appeal Brief and withdrawing the earlier rejection citing the Nagashima reference as not meeting the claims.

The Examiner indicated the options at this point are to file a reply under 35 CFR §1.111 or request reinstatement of the Appeal. Applicant has elected to file a reply under 37 CFR §1.111. However, no claims are amended herein.

Claims Rejections - §101 - Traversed

The Examiner rejected Claims 49 to 51 under 35 U.S.C. §101 on grounds of the claimed invention being directed to non-statutory subject matter. The Examiner stated “The claims mix apparatus and means for language and are therefore not statutory.”

This rejection is traversed. 35 U.S.C. §101 is not directed to the form of the claims but instead to their subject matter. Clearly the subject matter of Claims 49-51 is in the realm of patentable subject matter. There appears to be no provision for a rejection of this type under §101.

MPEP §2164.08(a) does proscribe “single means” claims. MPEP §2164.08(a) states “A single means claim, i.e. where a means recitation does not appear in combination with another recited element of [sic] means, is subject to an undue breadth rejection under 35 U.S.C. §112, first paragraph.” (Presumably, this should read “or” rather than “of”.) In any case, clearly Claims 49-51 do not fall under this since these are dependent claims which necessarily recite the “means for” in

combination with other elements. Hence clearly any rejection as being a “single means” claim is not appropriate.

Moreover, MPEP does contemplate claims where one element is in “means for” form and other elements are not. See MPEP §2181 at page 2100-2111, first full paragraph, right hand column, which states “It is necessary to decide on an element by element basis whether 35 U.S.C. §112, sixth paragraph applies”. Clearly this contemplates a combination of “means for” elements with other types of elements. Hence again the §101 rejection lacks support in the law and it is respectfully requested that the Examiner reconsider and withdraw it.

Claims Rejections - 35 U.S.C. §102, §103

The Examiner rejected Claims 1, 33, 37, 49, 52, 54-56, and 58-59 under 35 U.S.C. §102(b) as anticipated by Lang. As regards Claim 1, the Examiner stated in pertinent part that Lang discloses:

a memory coupled to the tuner for storing data in the received broadcast signal in a database, see figure 3, (13), column 8, lines 38-50 and column 11, line 30;

a user interface for providing a set of menus describing the database, and for accepting selections from the set of menus, see column 11, lines 32-40 and column 8, lines 27-33;

In rejecting independent Claim 58, the Examiner made similar comments and cited the same portions of Lang.

The remaining claims were rejected under 35 U.S.C. §103 citing Lang in combination with Rovira and “Official Notice”. The Examiner indicated that Claims 43-44 were rejected as being dependent upon a rejected base claim but otherwise allowable if rewritten in independent form.

§102, §103 Rejections are Traversed

All the rejections under §102 and §103 are traversed. It is respectfully admitted that independent Claims 1 and 58 are not met by Lang or obvious in light of Lang. At least certain of the dependent claims additionally distinguish over the references.

The Examiner, in withdrawing the earlier rejection citing Nagashima, said that "...however, applicant is convincing regarding the user interface for selecting and accepting selections from the set of menus." It is respectfully submitted that for at least similar reasons the current rejection citing Lang is also subject to reconsideration and withdrawal since, similar to Nagashima, Lang fails to meet this and other elements of the current claims, as set forth in detail hereinafter.

Lang Reference

Lang is directed to (see Abstract):

An improved video recorder/transceiver with expanded functionality ("VCR-ET") including a capability for storing video and video programs in digital format, editing such programs, transferring such programs onto a hard copy magnetic media, and transmitting such programs to a remote location using a second VCR-ET.

The primary storage medium is a conventional VCR. See Lang column 3, line 51:

The audio/video recording unit AVRU 11 may be a video cassette recorder similar to a conventional VCR in which the storage media 23 is a magnetic tape. Alternatively, AVRU 11 may operate with other types of storage media including, but not limited to, other magnetic tape formats. (Emphasis added.)

Lang also indicates use of other types of storage such as a CD-ROM, optical disk, etc. However the primary embodiments all use a VCR, as indicated by the name of the device "VCR-ET". VCRs, of course, have several limitations for data storage a primary one being the essentially sequential nature of data storage with no way for accessing particular portions of the tape, except for

a simple time-based approach using the time the tape has been playing or recording, or Lang's frame numbers which are also a sequential time-based approach. Magnetic tape (especially as played in a VCR) is generally not suited for random access storage or for storage of more complex data other than data to be accessed sequentially, as is well known in the field.

Although the Examiner read portions of Claim 1 (as quoted above) on Lang, Figure 3, column 8, lines 38-50 and column 11, line 30 as well as column 11, lines 32-40 and column 8, lines 27-33 as disclosing the "database" and the "set of menus describing in the database" it is not seen where in Lang there is any reference to a "database" or similar structure in these passages, nor any reference to a "set of menus" or anything to do with "menus."

There is description of a menu at Lang, column 6, beginning line 53 (not cited by the Examiner):

In addition, a program may be edited, one frame at a time, by changing the contrast, brightness, sharpness, colors, etc. ... In one embodiment, a display such as a flat panel video display (not shown) is built into the VCR-ET. A user interface control panel of DCU 14 allows a user to select a desired frame number from a menu on the display. The VCR-ET then displays a strip of frames (including several frames before and after the selected frame). The user can delete frames in a strip, select a point where other frames are to be inserted into the program, or edit different frames ... (emphasis added.)

Therefore the only relevant disclosure in Lang relating to menus appears to be this passage disclosing a single menu which merely shows a list of frame numbers to identify strips of frames. Presumably the user enters one of these frame numbers to select the desired strip.

However, there is no disclosure here of any "set of menus"; only the single menu is provided. This is consistent with the use of a VCR which only allows access by time or perhaps frame numbers (also time-based) and not by any other method relating to the recorded material. There is no indication of a "database" here. Instead in Lang, the recorded material or programs is merely recorded on tape by conventional sequential recording and is only accessed by time sequence or frame number. There is no reason to regard this as a "database"; it is merely a method

of reading out portions of a sequential recording based on time or frame number.

Claim 1 - Rejection Traversed

First, it is respectfully submitted that there is no disclosure of a “database” as recited in Claim 1 in Lang. Presumably the Examiner regards the recorded program material as being a database because portions (frame strips) of it can be selected. However, the selection of frame strips by Lang is based only on frame number, not on any other attribute. It is not seen how this is a “database” since there is no organization or access beyond the conventional VCR recording by sequential time, or frame number. There is no device or process in Lang for choosing a particular program or type of program or designating, for the user, which program or portion of a program he is selecting except by the frame number. Hence it is not seen how this passage of Lang (or any other) meets the claimed “database” of, for instance, Claim 1.

Second, given Lang’s simple approach to accessing the material for editing purposes, Lang also fails to meet the recitation in Claim 1 of “a user interface for providing a set of menus describing the database,”. At most in Lang there is a single menu listing a set of frame numbers. There is clearly no “set of menus”. Moreover, it is not seen how the Lang menu actually describes any database, first because there is no database in Lang, and second because there is no actual identification or description provided of anything in the database but there is only a listing of frame numbers indicating particular strips. Hence while arguendo, Lang has a user interface which accepts user selections, Lang fails to meet the remaining portion of the second clause in Claim 1 “a user interface for providing a set of menus describing the database, and for accepting selections from the set of menus;”.

For this second reason the Claim 1 rejection is traversed. It is clear that Lang fails to meet at least two elements of Claim 1 - the database and the set of menus.

Moreover, there is no motivation to modify the Lang disclosure to meet Claim 1. Lang emphasizes use of a VCR as his storage medium. VCRs have only a simple method of recording data, sequentially by time. (In fact it is not seen how the VCR-ET can record or recover Lang’s

frame numbers; Lang fails to disclose how this particular feature is actually enabled.) Given the simple sequential nature of VCR recording and access, it is not seen whether there is any motivation to modify the Lang disclosure to provide for a database of the material on the tape, or for accessing same using a set of menus. Hence Lang also fails to render Claim 1 obvious.

Claims 33-57, dependent upon Claim 1, distinguish over Lang for at least the same reasons as does base Claim 1.

Dependent Claim 51

Claim 51, it is respectfully submitted, is additionally allowable as reciting “means for designating by a broadcaster of the broadcast signal a hierarchy for the database.” (emphasis added.) The Examiner recognized that Lang failed to meet Claim 51 and rejected Claim 51 citing Lang further in combination with Official Notice. He said “Official Notice is taken that hierarchical databases are old and well known, ...” It is not argued that hierarchical databases were known prior to the filing of this patent application. However, contrary to the Examiner’s apparently unmotivated assumption, there is no reason to combine this fact with the Lang system. The Examiner provided no actual motivation for modifying Lang to have a hierarchical database. Hierarchical databases are a known method of structuring a database. However, as pointed out above, there is no disclosure of the term “database” in Lang, nor does Lang in effect teach a database since all he provides is a listing of frame numbers to access a sequential recording. It is not seen why this meets the term “database”. Moreover, in the context of Lang there would be no reason to have a “hierarchical database” since the only available method of organizing the data is sequential (frame numbers) and so a hierarchy would be meaningless since there is no other information to capture about any “database” available to the Lang VCR-ET. Therefore the rejection of Claim 51 is additionally traversed and it is respectfully submitted that Claim 51 distinguishes over the cited references for this additional reason.

Claim 58 - Rejection Traversed

The Examiner also rejected independent method Claim 58 citing the same portions of

Lang as cited in rejecting Claim 1. Again, the Examiner identified Lang as disclosing “storing the received information in a database” and “providing a set of menus describing the database.”

However, as pointed out above in connection with Claim 1, Lang does not provide a “database” nor suggest same, nor does he provide “a set of menus” describing any type of database. Hence at least for reasons similar to those pointed out above in connection with Claim 1, Claim 58 also distinguishes over Lang.

Thus all pending claims, it is respectfully submitted, distinguish over Lang even in conjunction with the other cited references and are allowable, and it is requested that the Examiner reconsider and withdraw his rejection of same.

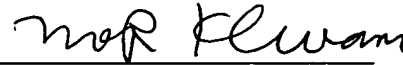
CONCLUSION

In view of the above, all pending claims in this application are believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone interview would expedite prosecution, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. **549222000101**. However, the Commissioner is not by this paper authorized to charge the cost of the issue fee to the Deposit Account.

Dated: April 30, 2004

Respectfully submitted,

By 

Norman R. Klivans

Registration No.: 33,003

MORRISON & FOERSTER LLP

755 Page Mill Road

Palo Alto, California 94304

(650) 813-5850